

REMARKS/ARGUMENTS

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claims 43-44, 47-53, 61, 71, and 75-77 have been amended solely for clarity, and new claim 82 is added. Thus, claims 43-44, 47-54, 57-62, and 65-82 are pending for further examination.

Objection to the Specification

Since the Examiner apparently is of the opinion that all antecedent basis issues can be resolved by amending the specification (see point 71 bridging pages 21-22 of the Final Office Action), Applicant requests that all such objections be held in abeyance until the claims are substantively allowable.

Rejections under 35 U.S.C. § 112, First Paragraph

Claims 43-44, 47-54, 57-62, and 65-81 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed for at least the following reasons.

With respect to the recitation of the instances of media in the first and second storage locations being of one common song data type, reference is made to paragraphs 9-10 of the instant specification. Paragraph 9 indicates, for example, that “the user can first search the local storage on the jukebox for desired songs and then, if desired, search further on the local server for desired songs.” One skilled in the art would understand from this sentence that first and second storage locations are provided (local storage on the jukebox and storage on the local server), and that one common type of data is provided on each (song data). Paragraph 10 confirms this view, indicating that “the local server is periodically updated with data (e.g., songs) to correspond with the contents of the master library of data (e.g., songs).” One skilled in the art

would understand that multiple types of data are possible, but that the song data for instance is provided to the master library and the local server. The concepts of “types” is present, as is the concept of storing one common type of data to plural storage locations.

The remaining issues are believed to be rendered moot by virtue of the minor clarifying amendments proffered herein. Needless to say, Applicant does not acquiesce to the propriety of any of these rejections.

Reconsideration and withdrawal of all § 112, first paragraph rejections are respectfully requested.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 43-44, 47-54, 57-62, and 65-81 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. This rejection is respectfully traversed for at least the following reasons.

As an overarching issue, Applicant once again notes that all of the Examiner’s issues appear to relate to the breadth of the claims rather than any lack of clarity. Applicant thus points out once again that breadth is not to be confused with indefiniteness. See MPEP 2173.04, aptly entitled “Breadth Is Not Indefiniteness.” The MPEP’s guidance on these issues could not be clearer, and the rejection is facially improper for at least this reason.

With respect to “types,” the Final Office Action’s examples are interesting but inapposite in view of the express language of the claims and at least the explanation in at least paragraph 10 quoted above. This example indicates that one type is a “song data type” -- which also happens to clearly define over the alleged combination of references that provide different types of media on different storage locations.

Encryption types are admitted to be known. The fact that there are multiple types of encryption with multiple levels does not render this claim unclear or indefinite in any way.

Again, the Examiner is encouraged to read MPEP 2173.04 for guidance on this issue.

Reconsideration and withdrawal of all § 112, second paragraph rejections are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 43-44, 47-49, 53-54, 57-62, and 65-67 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles (U.S. Patent No. 5,481,509) in view of Verduin (U.S. Patent No. 4,667,802); claims 50-51 and 68-69 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Verduin in view of Bowman-Amuah (U.S. Patent No. 6,289,382); and claims 52 and 70 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Bowman-Amuah, and further in view of Dunning (U.S. Patent No. 7,024,485). These rejections are respectfully traversed for at least the following reasons.

Claim 43 recites, *inter alia*, “a first storage location storing a first plurality of instances of media available for playback via the jukebox device for a first fee or number of credits; [and] a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits . . . wherein the first storage location is different from the second storage location, and wherein each said instance of media in the first and second storage locations is of one song data common type.” Claims 53 and 61 recite similar subject matter. These features are not present in Knowles or Verduin, alone or in combination.

Thus, Knowles and Verduin, alone and in combination, do not render obvious these claims (or their dependents).

The Final Office Action concedes that Knowles does not teach or suggest “a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits . . . wherein the first storage location is different from the second storage location” and cites to Verduin of make up for this admitted deficiency. Verduin relates to a video jukebox system. An object of Verduin’s invention “is to provide a video jukebox which provides for independent pricing of audio-video and strictly audio selections” (col. 1, lines 31-33). A further object Verduin’s invention is to “provide a video jukebox . . . which distinguishes between video and audio selections” (col. 1, lines 35-36). Verduin makes clear that its “video jukebox permits . . . the independent pricing of video and audio selections” (col. 6, lines 23-24). When Verduin is read as a whole, it becomes clear that there is absolutely nothing in Verduin that teaches or suggests the independent pricing of different subsets of video selections or different subsets of audio selections. As a result, Verduin does not teach or suggest the above-identified subject matter of claims 43, 53, and 61.

Even the alleged combination -- to the extent divined from the Final Office Action -- is deficient in this regard. Indeed, the Final Office Action does not appear to make any allegations regarding how one of ordinary skilled in the art at the time of the invention would have combined Knowles and Verduin. Applicant assumes that when the references are considered as a whole, the resulting combination would have been only a slightly more up-to-date version of Verduin in which a user is charged a first price for video selections and a second price for audio selections. But this combination is nothing like claims 43, 53, and 61 because it does not charge

two different prices for a single type of instance of media based on the storage location storing that media.

Of course, the alleged motivation for combining Knowles and Verduin appears to be improper. The allegation that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Knowles to designate each of the hard disks 52 for different priced media because then the computer could identify the hard disk and charge accordingly instead of having to add metadata to the files or create a lookup table” is not supported by the references of record. For example, the words “metadata” and “lookup table” are not present in either of Knowles or Verduin. Of course, Applicant does not understand how Verduin’s price differentiation techniques for completely different media types and media sources could help “to designate each of the hard disks 52” of Knowles. The differences between a VCR and a record player in Verduin seem to be much greater than the differences between the different hard disks in Knowles -- especially since Knowles does not appear to specify what type of media goes on a particular hard drive. Indeed, the Final Office Action has not (and likely cannot) answer basic questions like what types of metadata are stored for VCR recordings, where such metadata is stored, how it is accessed, what it represents, etc. Simply stated, the Final Office Action lacks the necessary underlying facts to support the legal conclusion of obviousness. This is a further problem with the rejection of the above-identified claims (and their dependents).

The introduction of the additional references does not make up for the underlying fundamental deficiencies with respect to the alleged Knowles/Verduin combination. Thus, Applicant respectfully requests that all § 103 rejections be reversed as to claims 43, 53, and 61, and their respective dependents.

Claims 71-80 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Shneidman (U.S. Publication No. 2006/0038794); and claim 81 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles and Shneidman, and further in view of Verduin. These rejections are respectfully traversed for at least the following reasons.

Knowles simply does not teach price differentiation of any kind -- much less “a user interface provided to the jukebox device configured to receive input from a user corresponding to a selection of an instance of media from the instances of media in order to initiate playback of the selected instance of media on the jukebox device, the user interface comprising a first display screen configured to receive input from a user for the selection of the instance of media for playback from the first subset of media for a first fee or number of credits, and a second display screen configured to receive input from a user for the selection of the instance of media for playback from at least the second subset of media for a second fee or number of credits, the second fee or number of credits being greater than the first fee or number of credits,” as called for in claim 71. The reliance on step 136 in Fig. 4A of Knowles is not understood. Knowles at col. 6, lines 50-52 merely states, “Once a genre has been selected, the program displays the titles available along with the price to play each title for the format and genre selected at a step 136.” But this single sentence says nothing of first and second display screens, much less of different prices being charged for whether a selection is made from the different screens. There is nothing in Knowles that teaches or suggests such a feature, and the introduction of Shneidman certainly does not make up for this fundamental deficiency of Knowles.

The further introduction of Verduin does not make up for this deficiency. Thus, reconsideration and withdrawal of these § 103 rejections are respectfully requested.

New Claim

New Claim 82 has been added to encompass additional originally disclosed subject matter. New claim 82 should be allowable over the cited art at least by virtue of its dependence from claim 43.

Conclusion

Applicant believes that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, passage of this case to issuance at an early date is earnestly solicited. Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Joseph S. Presta/

Joseph S. Presta
Reg. No. 35,329

JSP:JR/jnm
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100